

## **REMARKS**

This amendment and response responds to the Examiner's Office Action dated on July 13, 2007.

Claims 1, 3-8, 10-13, 15, 17, 19-23, 25, 26, 29-36, 38, 42-47, 49, 50, 52-57, and 66-68 are amended, claims 14, 16, 18, 37, 39, 48, 51, 58, 61-65, and 70 are canceled, and no claims are added; as a result, claims 1, 3-8, 10-13, 15, 17, 19-23, 25, 26, 29-36, 38, 42-47, 49, 50, 52-57, and 66-68 are now pending in this application.

### **Objections to the Specification**

An objection made to the specification for proper antecedent basis remains for two of the five limitations of the originally filed claims (8/21/2001). Specifically, the specification was objected to as failing to provide proper antecedent basis for the following claimed subject matter:

1. The markers are inserted into said video stream to indicate the division between video segments by changes in music within said video stream.
2. The markers are inserted into said video stream to indicate the division between video segments by changes in scenery within said video stream.

In response, the Applicants have amended paragraph 0020 of the written specification to include a sentence that discloses the claimed subject matter. Support for the amendment can be found in the originally filed claims 34 and 35 that disclose inserting markers based on changes in music within said video stream and changes in scenery within said video stream, respectively. No new matter has been added. Withdrawal of the last two remaining objections to the specification is respectfully requested.

### **Amendments to the Specification**

The Applicants noted a few minor informalities within the written specification as originally filed. The written specification has been amended in order to correct these informalities. No new matter has been added to the written specification.

§112 Rejection of the Claims

Claims 5, 14, 17, 18, 29-32, 34, 35, 67 and 68 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. All of these rejected claims have been amended to remove the offending material, have been canceled, or are now supported by the written specification due to the amendments set forth in the preceding section.

Claim 17 has been amended to claim material that is supported by the written specification after amendment. The amendment to the written specification does not add new matter since the amendment merely copies material claimed in an originally filed claim into the written specification. Specifically, the sentence “A user may download the selected video segments 80 from the video storage 60.” was added to paragraph 0026 of the written specification. Support for this amendment to the written specification can be found in originally filed claim 15 that claimed “downloading said selected video segments from said video content stored in said local storage for viewing by said viewer.”

In light of these amendments to the rejected claims, cancellation of some rejected claims, and amendment to the specification, withdrawal of the rejections under 35 U.S.C. § 112, first paragraph is respectfully requested.

§103 Rejection of the Claims

Claims 1, 5-7, 10, 11, 14-20, 22, 23, 38, 39, 61, 62 and 70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565).

Claims 3, 8, 21 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 1 above, and further in view of Kwoh (U.S. Patent No. 6,226,793).

Claims 4, 33 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 1 above, and further in view of Maybury et al. (U.S. Patent No. 6,961,954).

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 1 above, and further in view of Elam (U.S. Patent No. 6,216,263).

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 1 above, and further in view of Abecassis (U.S. Patent No. 5,664,046).

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 19 above, and further in view of Eyer (U.S. Patent No. 6,483,547).

Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 19 above, and further in view of Beckman et al. (U.S. Patent No. 6,675,388).

Claims 29 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 19 above, and further in view of Elenbaas et al. (U.S. Publication No. 2005/0028194).

Claims 30, 32 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 19 above, and further in view of Ahmad et al. (U.S. Patent No. 6,880,171).

Claims 31 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 19 above, and further in view of Gove (U.S. Patent No. 5,099,322).

Claims 42, 43, 45, 46, 49-51, 56-58, 64 and 65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Kwoh (U.S. Patent No. 6,226,793) and Legall et al. (U.S. Patent No. 6,005,565).

Claims 44, 54 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Kwoh (U.S. Patent No. 6,226,793) and Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 42 above, and further in view of Rosser (U.S. Patent No. 6,446,261).

Claims 47 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Kwoh (U.S. Patent No. 6,226,793) and Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 43 above, and further in view of Cobbley et al. (U.S. Patent No. 5,614,940).

Claims 52 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Kwoh (U.S. Patent No. 6,226,793) and Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 50 above, and further in view of Reilly et al. (U.S. Patent No. 5,740,549).

Claim 63 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Maybury et al. (U.S. Patent No. 6,961,954) and Legall et al. (U.S. Patent No. 6,005,565).

Claims 67 and 68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. Patent No. 6,011,895) in view of Legall et al. (U.S. Patent No. 6,005,565) as applied to claim 19 above, and further in view of Elenbaas et al. (U.S. Publication No. 2005/0028194) and Ahmad (U.S. Patent No. 6,880,171).

The Applicants have amended the claims to better highlight the novel features of the present invention. Since the Applicants have significantly amended the claims, the Applicants will set forth the reasons why the amended claims are allowable over the cited art instead of directly addressing Examiner's rejection of the previous claims that are now largely moot.

#### Independent Claims 1, 15, 17, and 19

Independent Claims 1, 15, 17, and 19 are now directed to a method and system for receiving, decoding, and storing an encoded video stream. Specifically, the claims cover the teachings of the various systems disclosed in **Figures 2 through 5 and 9**. In these systems, an

encoded video stream consisting of a continuous series of video segments is decoded to retrieve markers and tags. The markers define divisions between the video segments in the continuous series of video segments. Tags associated with each video segment describe the content of the associated video segment. The video segments of the video stream, as identified by the markers, are stored into a video storage in the system. The system can then select preferred video segments from the continuous series of video segments by comparing the tags describing the video segments with video preferences of a viewer. The selected video segments may then be viewed by the user or downloaded. Independent Claims 1, 15, 17, and 19 all include limitations of receiving a video stream comprising a continuous series of video segments, decoding the markers that divide the video segments, decoding the tags that describe the video segments, storing the video segments in video storage, and comparing the tags against the video preferences of a user to select preferred video segments.

In the office action dated July 13, 2007, the Examiner cited Abecassis (U.S. Patent No. 6,011,895) (hereinafter referred to as the Abecassis reference) as a main reference that rendered the present invention obvious. The Abecassis reference discloses a keyword responsive variable content video program system. The system of the Abecassis reference is largely a video disk player **601** that is capable of accessing a content map in order to skip over video segments depending on user content preferences. (See Abstract of the Abecassis reference) The system of the Abecassis reference also discloses an alternate embodiment wherein an individual program and its associated content map be received from a remote source. (See the text of the Abecassis reference starting at line 50 of column 13.)

The system of the present invention differs from the system of the Abecassis reference in that the system of the present invention is directed toward a system that must handle a video stream **consisting of a continuous series of video segments**. To handle the continuous series of video segments, the system first decodes the video stream to obtain markers that identify individual video segments. The system stores the identified video segments in a video storage. The system also decodes tags associated with each individual video segment that provide information relating to the video segment. The system uses the tags to be able to select preferred video segments from the continuous stream of video segments. The system of Abecassis

reference cannot handle an encoded video stream consisting of a continuous series of video segments. Instead, the system of the Abecassis reference relies upon a content map that must be present. For example, the sentence from line 53 to line 57 states “The disk contains the map of the program segments, any user interface routines particular to the program, and player control codes in a format similar to that require by the actual program contained therein” When the system plays a disk, the system “would apply the stored viewer preference structure to the program content map.” The system of the present invention, as claimed, must handle a continuous series of video segments. Such a continuous series of video segments has no pre-made content map. Since the Abecassis reference requires a content map, the system of the Abecassis reference simply would not be able to handle such a continuous series of video segments.

In fact, the system of the Abecassis reference teaches away from the system of the present invention. As set forth above, the Abecassis reference does disclose four different embodiments that operate using video information received from a remote source. However, none of these four embodiments operates using a video stream consisting of a continuous series of video segments. The first embodiment (column 14, lines 50 to 64), third embodiment (column 15, lines 9 to 52), and fourth embodiment (column 15 line 53 to column 16 line 12) of a remote video source based system all require that the user’s preference information be transmitted to the remote source such that the remote source may analyze the user’s video preference information, apply it to a content map at the remote video source, and deliver selected individual video segments. The second embodiment (column 14, line 65 to column 15, 8) does allow multiple segments to be delivered, however those multiple video segments are delivered to the receiver system along with the content map to all the video segments. Specifically, the second embodiment is described as follows:

In a second example, a user will access a program provider and select a program, as indicated in the example above. Instead of remaining on-line, however, the user requests downloading the selected program. **In addition to the program video, the program includes a map of the program segments, any user interface routines particular to the program, and VRT control codes, in a format consistent to that required by the VRT storage capabilities.** Utilization of the program will then be analogous to those steps detailed previously for the player implementation of the present invention.

Thus, even though the Abecassis reference disclosed various embodiments for wherein video information was transmitted to the system from a remote location, none of those embodiments could handle selecting video segments from a continuous series of video segments as is performed by the presently disclosed and claimed system.

Since the system of the Abecassis reference requires a content map of video segments in order to operate, it thus cannot receive and handle a continuous series of video segments as claimed by amended independent claims 1, 15, 17, and 19. Thus, the system of the Abecassis reference does not anticipate nor render unpatentable due to obviousness, the present invention as claimed by amended independent claims 1, 15, 17, and 19 nor any claims dependent up on those claims.

#### Independent Claim 42

Independent claim 42 has been amended to cover the novel video production system disclosed in **Figure 6**. Specifically, claim 42 claims a video production system that generates a primary video stream and an alternate video stream wherein both video streams are encoded with markers and tags. None of the references cited by the examiner disclose such a dual output video production system.

#### Double Patenting

Applicant was advised that should claims 33 and 66 be found allowable, claim 66 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate thereof. In response, Applicants have amended claim 66 to make it clear that it covers a different invention. Specifically, claim 33 claims inserting markers (that designate the beginning and end points of video segments) whereas claim 66 claims inserting tags (that describe the content of the video segment). Support for claim 66 can be found on line 9 of page 8 of the originally filed specification.

**Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.



**PRELIMINARY AMENDMENT**

Serial Number: 09/933,928

Filing Date: August 21, 2001

Title: **iSELECT SYSTEM AND METHOD OF SELECTING AND EXCLUDING VIDEO SEGMENTS BASED UPON TAGS, MARKERS, AND VIDEO PREFERENCES**

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**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 408-278-4041 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11 day of January, 2008.



Name



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